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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,120	09/18/2002	Scott C. Harris	GPSPrivC1	8217

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EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
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3662

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,120

Applicant(s)

HARRIS, SCOTT C.

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The claims have been improperly marked in the most recent amendment. Claims 37-50 have been identified in the response as "withdrawn". However, the listing of the claims does not indicate such and instead indicates "original". Applicant is required to correct such in any further response.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 9-15 and 17-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson et al.

4. Lemelson et al disclose a remote security location device 10 combining a positioning device 34 and a communication transceiver 24 wherein a user inputs a PIN to control access from the remote for privacy without disabling the operation of the integrated device. The controlled access disables the transmission of location signals from the remote unit 10 to a central station 35.

5. Claims 9-15 and 17-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Zellner et al.

6. Zellner et al disclose the claimed method and apparatus for user control of the blocking of user location information transmission in a wireless communication system, see Figure 3, including a handheld unit 200 having a location system 220, such as a GPS receiver, a user interface 202 for enabling user control of the enabling or blocking of position reporting, and a location block device processor that is responsive to the location system and user interface for controlling the processing

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and communication. The system enhances the privacy of the wireless handheld device. The user interface may comprise any of a plurality of menus, buttons, or key sequences.

7. Claims 9-15 and 17-35 are rejected under 35 U.S.C. 102^e(b) as being anticipated by Moles et al.

8. Moles et al disclose the claimed method and apparatus for providing location privacy in a wireless mobile communication device. Control circuitry is capable of being selectively set to disable the transmission of information concerning the location of the mobile station. Figure 2 shows the mobile device including a position device 260, a transceiver 210, I/O interface 245, keypad 250, display 255, and a main controller 240 having an associated memory with privacy flag information.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Lemelson et al, Zellner et al or Moles et al, each in view of Seiple et al.

The prior art references to Lemelson et al, Zellner et al or Moles et al teach the prevention of position reporting in integrated GPS/mobile communication devices to provide enhanced privacy but fail to show the prevention of the GPS receiver from determining position (claim 1) or the method wherein position cannot be automatically detected by the GPS receiver (claim 3). Seiple et al teach the conventionality in an integrated GPS receiver/communication transceiver to provide the user with the capability of placing a GPS receiver in a standby mode when not in use in order to reduce power consumption. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to modify any one of Lemelson et al, Zellner et al or Moles et al by disabling the GPS receiver when a position determination is not required, such as in the position reporting blocking mode of the prior art references, so as to provide a power saving function as taught by Seiple et al. The combination thus suggests that during the position reporting blocking mode, the position receiver is not required and as such, power savings can be provided by disabling the function of the GPS receiver.

11. Claim 1 is objected to because of the following informalities: in claim 1 "said electronic device" lacks a proper antecedent basis since the claims have been amended to be directed to a cellular phone. Appropriate correction is required.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

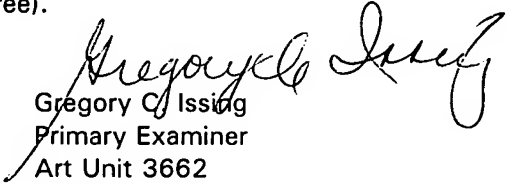
13. Raith discloses a method and apparatus for releasing location information in a mobile communication device; the user controls the release of the location information to provide a degree of privacy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is 703-306-4156. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci